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In the Supreme Court of the United States

Office-Supreme Court, U.S.
FILED
NOV 8 1968
JOHN F. DAVIS, CLERK

OCTOBER TERM, 1968

No. 600

ARCHITECTURAL MODELS, INC., a California corporation,

Petitioner,

vs.

NILS C. NEKLASON and DONALD NUSBAUM, doing business as SCALE MODELS UNLIMITED,

Respondents.

Petitioner's Reply and Supplemental Brief

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The Conflict Between the Ninth Circuit and the Patent Office

Respondents attempt to imply that the Petition presents issues of fact on which two courts below have agreed. There are no issues of fact in this case.

There is no dispute about the content of the prior art or the structure or mode of operation of either Petitioner's or Respondents' machine. Respondents have not questioned the truth of any of the factual statements in the Petition, and Petitioner doesn't question the truth of any factual statement in Respondents' Brief. There is no dispute about what the claims say; literally they are infringed by Respondents' machine.

What this case does involve is an important legal issue: "Do patent claims mean what they say?" The Patent Office and the lower courts are in direct conflict on this issue.

The Conflict Between the Ninth and Fifth Circuits

Since the Petition was filed in this case a decision has been reported from the Court of Appeals for the Fifth Circuit which is in direct conflict with the Ninth Circuit decision on the basic issue "Do patent claims mean what they say?"

In *Williams Bit & Tool Co. v. Christensen Products Co.*, 399 F.2d 628, decided August 19, 1968, the lower court had held a patent valid but not infringed even though the defendant's devices fell within the literal words of a claim of the plaintiff's patent. The lower court had reached its decision based on arguments made to the Patent Office by the patentee's attorney, as the District Court in this case based its decision on the arguments quoted in the appendix to Respondents' Brief.

The Court of Appeals for the Fifth Circuit reversed the holding of non-infringement because the patent claim meant what it said. The Court said at 399 F.2d 634:

> "Here the district court found, and we agree, that the defendant's accused stepfaced bit falls within the literal words of claim 5 of the patent in suit. This should have ended the inquiry so far as concerns the alleged estoppel since, as we have pointed out, it is the language of the specification and claims which the Patent Office has approved which defines and limits the invention. *It was, therefore, error for the court to deny to the plaintiffs the literal scope of their claim 5 and to hold, on the basis of an attorney's argument in the Patent Office, that the claim must be limited beyond what its language requires.* In Graver Tank Co. v. Linde Air Prod. Co., 1950, 339 U.S. 605, 607, 85

> USPQ 328, 330, the Supreme Court said, "In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it." It is true that in the Graver Tank Co. case the Supreme Court recognized, as it had done in Westinghouse v. Boyden Power Brake Co., 1898, 170 U.S. 537, 568, that the doctrine of equivalents which is ordinarily available to a patentee may not be applicable in the case of an accused device which, although within the language of the claim, has so far departed from the principle of the patent and performs its function in so different a way as not to represent the invention. The district court applied this exception in the present case, we think wrongly." (emphasis added)

It is therefore apparent that there is a sharp and present conflict between the Ninth Circuit on the one hand and both the Fifth Circuit and the Patent Office on the other, and this conflict is fundamentally important to the day by day operation of the Patent System.

This Court should resolve this basic conflict as to whether patent claims mean what they say so that the Patent Office and the courts will apply the same standards in granting and enforcing patents and so that the scope of a patent claim will not depend on the circuit in which it is litigated. If this conflict is not resolved, continuing uncertainty will dissuade inventors from publishing their inventions and dissuade manufacturers from introducing new products because neither will be able to predict the scope of a patent with any degree of certainty.

Respectfully submitted,

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